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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,354	07/28/2005	Johann Matuschek	3105	4238
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743			EXAMINER	
			LE, MARK T	
			ART UNIT	PAPER NUMBER
			3617	
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			07/21/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,354

Applicant(s)

MATUSCHEK ET AL.

Examiner

MARK T. LE

Art Unit

3617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14, 18-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 11/19/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election with traverse of Species II in the reply filed on June 25, 2008 is acknowledged. The traversal is on the ground that all embodiments include the functional surfaces being made with a given oversize and machined down to a predetermined dimension. This is not found persuasive because currently there is no evidence that such feature is a special technical feature.

The requirement is still deemed proper and is therefore made FINAL.

2. It is noted that Applicant's election includes claim 17, which depends from non-elected claim 15. Therefore, claim 17 is also withdrawn from further consideration along with claim 15.

3. The abstract of the disclosure is objected to because phrases that can be implied, such as "Disclosed is ...", line 1 of the abstract, and legal phraseologies, such as "said"/"means", should be avoided. Correction is required. See MPEP § 608.01(b).

4. In the specification, references to the instant claims, e.g. made on page 1, line 5, and in the first four lines of page 6, should be deleted because the claims may change during the course of prosecution.

5. Claim 20 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should depend from other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

6. Claims 1-8, 14, 18 and 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 6, "the ... second functional surfaces" lacks antecedent basis. It appears that the second functional surfaces refer to the "two functional surfaces (19) in the form of stator core mounting surfaces" recited in the preceding part of the claim. Proper correction is required.

In claim 15, line 2, "the slide rails (25)" lacks antecedent basis.

In claim 18, line 4, "the lateral inclination" lacks antecedent basis.

In claim 21, "the lateral direction" lacks antecedent basis.

Claims 22-26 are indefinite because the steps that makeup the claimed method are not clearly defined.

In claim 22, line 3, the expressions "the tolerances typical for steel construction" (note also claim 23), and line 7, "the tolerances required by the driving properties" are indefinite because it is not clear as to the values that are covered by the instant claimed tolerances. Furthermore, said expressions "the tolerances typical for steel construction", and "the tolerances required by the driving properties" lack antecedent basis.

In claim 24, it is not clear as to what are the works covered by "the welding work relevant for the positional accuracy of the functional surface". Furthermore, the expressions "the welding work relevant for ..." and "the positional accuracy" lack antecedent basis.

In claim 26, line 3, the lateral inclination" and "the supports" lack antecedent basis.

7. Due to the indefinite nature of claim 24, claim 24 cannot be further treated on the merits.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-7, 14, 19, 21-23 and 25 (22-23 and 25 as best can be treated) are rejected under 35 U.S.C. 103(a) as being unpatentable over Reichel (US 6,785,945).

Reichel discloses structures 3 which are readable as driveway modules that have functional surfaces in the form of guiding surface, gliding surface, and stator core mounting surface; wherein, the functional surfaces are embodied on oversized pieces of equipment 1, which are machined down by cutters or milling devices 33.

Regarding the instant claimed pieces of equipment being made of steel, it is noted that Reichel does not describe as to whether pieces of equipment 1 are made of steel; however, it would have been obvious to one skilled in the art to made structures 1 of Reichel from steel for achieving expected strength thereof; and on the other hand, since structures 1 of Reichel are welded to steel rods 10,11, it would have been obvious to one skilled in the art to construct structures 1 of Reichel from the same material of the steel rods 10,11 for easy welding. Similarly, regarding the instant claimed modules being made of steel, as recited, it would have been obvious to one skilled in the art to made modules 3 of Reichel from steel so as to achieve the expected strength of steel.

Regarding the instant claimed pieces of equipment composed of laterally guiding rails or slide rails fixed to the top sides of the modules, as recited in instant claims 3-4, note that in the structure of Reichel, as in the assembled condition as shown in Figure 4 of Reichel, the pieces of equipment are readable as being composed of laterally guiding rails and slide rail fixed to the top of the modules, as broadly claimed.

Regarding the instant claimed modules having plate-like configuration, as recited in instant claim 6, note that modules 3 of Reichel have plate like structure 25.

Regarding the instant claimed elastically twistable, as recited in instant claim 21, it is considered that structures 3 of Reichel are elastically twistable when enough forces are applied to twist the structures.

Regarding the instant claimed module and pieces of equipment being joined by welding, as recited in instant claims 2 and 23, it is noted that modules 3 and pieces of equipment 1 of Reichel are joined by bolts 16; however, welding and bolt connections

are well known alternatives in the art of connections (Official Notice is taken).

Therefore, it would have been obvious to one skilled in the art to alternatively use welding instead of bolt connections in the structure of Reichel so as to provide more secured connections.

Regarding instant claim 7, consider the lateral wall of equipment piece 1, which is readable as a stator carrier fixed to the underside of module 3 as shown in Figure 4 of Reichel.

Regarding instant claim 14, note that modules 3 shown in Figure 4 of Reichel are readable as non-jointly-carrying components.

10. Claims 8, 18 and 26 (26 as best can be treated) are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertin (US 3,841,223).

Regarding the instant claimed modules being fixed to the support or carrier in a twisted state, note that Reichel shows only an exemplary straight track portion; however, tracks are well known to have curved portions to allow changes in the direction travels. See for example Figure 1 of Bertin. Therefore, it would have been obvious to one skilled in the art to include curved track portions in the track of Reichel, as well known, so as to allow changes in the direction of travel; and upon having such curved track portions, it would have been obvious to one skilled in the art that such modules 3 of Reichel would require a configuration of a twisted state that is conformed to the curved track portions for proper operations. As to claim 8, note that the structure of Reichel, as modified, includes curved track portions; therefore, the bends recited in claim 8 are obviously included.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK T. LE whose telephone number is (571)272-6682. The examiner can normally be reached on Mon-Fri, between 8:15-4:45 (Teleworking).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Le/
Primary Examiner
Art Unit 3617

mle
7/17/08